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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/910,738	07/23/2001	Tomohiro Uchida	01436/LH	2686

1933 7590 02/24/2006

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EXAMINER

LE, VU

ART UNIT PAPER NUMBER

2613

DATE MAILED: 02/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/910,738

Applicant(s)

UCHIDA ET AL.

Examiner

Vu Le

Art Unit

2613

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 36-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 36-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 14, 2005 has been entered.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first and second paragraphs of 35 U.S.C. 112 respectively:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 36-46 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

a. Claim 36, line 12-14, the phrase "wherein the image data stored ... is not changed even when the display magnification of the displayed section is changed" as now claimed has no support from the specification as originally filed.

Applicant asserts in the "Remarks" that support can be found on fig. 19 and on page 39, line 19 to page 40, line 2 of the specification. However, the referenced citations lack description of an image memory and/or details of the limitation "wherein the image data stored ... is not changed even when the display magnification of the displayed section is changed" as now claimed.

Clarification is requested.

Assuming arguendo that the above-mentioned limitation has support, the fact that an originally stored image is displayed at a higher magnification does not necessarily impact said stored image. Unless such magnification requires further image processing of said stored image. Again, Examiner fails to ascertain from Applicant's specification that at least describes displaying a stored image at a higher magnification without requiring further image processing of said stored image.

4. Claims 36-46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a. Claim 36, line 8, the phrase "the observation element" lacks prior antecedent basis. For art rejection, it will be construed as "the imaging element" until Applicant clarifies the issue in the next response.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 36-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bacus et al, US 6,226,392.

Re claim 36, Bacus discloses an imaging apparatus for a microscope (fig. 5), comprising:

an imaging element (14) which picks up an observation image (24) of a sample ( col. 7, line 38-50, col. 8, line 59-62) formed in a microscope body (142);

a display section (22) to display the observation image at a plurality of display magnifications (col. 7, line 35-50);

a shutter which is operable to pick up the observation image of the sample by the observation element [*the observation element is construed as the "imaging element" as stated in the 112<sup>nd</sup> paragraph rejection*]; Although Bacus does not explicitly disclose a shutter as now claimed, a shutter and its operation would have been implied in Bacus as evidenced by the camera controller 124 and image acquisition controller 130 (for details, see also figs. 4B, 5: elements 124, 130);

and a storage section ( 62, col. 7, line 59-63) which stores image data, corresponding to the observation image, picked up by the imaging element in accordance with a shutter operation of the shutter;

wherein the image data stored in the storage section will not be changed even when the display magnification of the display section is changed (fig. 5: 26, col. 7, line 38-50, i.e., a high magnification displayed image 26 is magnified without effecting any changes in the stored low magnification image).

Re claim 37, although Bacus does not specifically disclose a mode switch as claimed, Official Notice is taken to note that it would have been obvious and necessitated in Bacus to switch between an acquired image (i.e., scanned) for immediate display and an archived image (i.e., stored) for reproduction display for the benefit of image analysis and comparison since both types of images are readily available, and Bacus does involve image analysis.

Re claim 38, Bacus discloses the same operation section as claimed (see figs. 5-6, col. 8, line 4-7, col. 8, line 63 – col. 9, line 2).

Re claim 39, Bacus discloses the same display magnification as claimed (see figs. 5-6, col. 7, line 34-50).

Re claim 40, with reference to the discussion of claim 36 above, in Bacus, the low magnification image 24 is representative of the central portion of the observation image as claimed because it provides a "central" macro view of an entire observed image region in which a portion of it may be magnified into high magnification image 26 (see fig. 5, col. 7, line 34-50).

Re claim 41, see discussions in claims 36, 39 and 40.

Re claim 42, which further recites wherein in the reproducing mode, the operation section is operable to move the designated part of the observation image within the observation image, Bacus discloses the same (see col. 9, line 35-64).

Re claim 43, which further recites wherein in the reproducing mode, the operation section is operable to cause the display section to display an index indicating the part of the observation image, Bacus discloses the same (see figs. 1-3, col. 32-45; in Bacus, the windows 24 as shown in fig. 2 defines an index scheme to prevent image overlapping and interference so that extensive image processing is avoided).

Re claim 44, which further recites wherein in the reproducing mode, the at least one designated part of the observation image comprises a plurality of designated parts, and the operation section is operable to cause the display section to display the designated parts in list, Bacus discloses the same (see col. 10, line 37-45, i.e. the tiled images are displayed as a list-see fig. 2).

Re claim 45, which further recites wherein in the reproducing mode, the operation section is operable to cause the display section to display the designated parts in the list reduced scale, Bacus discloses the same (see discussion of claim 44 and also, in Bacus, the tiled images are displayed at reduced scale-see figs.1-3).

Re claim 46, which further recites wherein in the reproducing mode, the operation section is operable to cause the display section to display the designated parts in the list magnified in scale, Bacus discloses the same (see discussion of claims

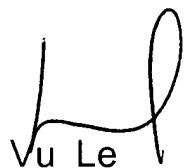
44-45, also in Bacus, portion(s) from the displayed list of tiled images may be selected for magnified view 26-figs.1-3).

### **Contact**

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vu Le whose telephone number is (571) 272-7332. The examiner can normally be reached on M-F 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, James Groody, can be reached on (571) 272-7950. Customer Service can be reached at (571) 272-2600. The fax number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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